## REMARKS/ARGUMENTS

The non-final Office Action of April 19, 2004, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 1-34 remain pending.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adan et al. (U.S. Patent No. 6,373,047, hereinafter referred to as *Adan*) in view of Zenz, Sr. (U.S. Patent No. 5,841,425, hereinafter *Zenz*) and Eichstaedt et al. (U.S. Patent No. 6,218,958, hereinafter *Eichstaedt*). Applicants respectfully traverse this rejection.

The Action alleges that *Adan* shows all the features of Applicants' independent claim 1, but states that, "Adan does not teach an illumination member of an input device that changes states." To overcome this deficiency, the Action relies on *Zenz*.

Applicants' independent claims 1 and 28 each recite, among other features, "communicating with a computer input device having an illumination member to cause the illumination member to change states responsive to the determining step." Contrary to the Action's assertion, the combination of *Adan* and *Zenz* fails to teach or suggest at least this feature of Applicants' independent claims 1 and 28.

*Adan* describes an input device that at best detects images on a surface. (Col. 2, line 61). More specifically, *Adan* relates to an input device for providing position information to a computer based on the movement of the input device. (Col. 1, lines 26-29). However, as admitted by the Action, *Adan* clearly fails to teach or suggest an illumination member. Further, *Adan* fails to teach or suggest communicating with a computer input device as claimed. *Adan* fails to teach or suggest transmission of information from the serial interface 46 to the mouse 42.

*Zenz* describes an ambidextrous computer input device that at best indicates if a computer input device 30 is being properly operated by a user's hand. (Col. 4, line 59 – col. 5, line 4). Although the computer input device 30 has a visual indicator 48 and the state of the visual indicator can change, e.g., "on" or "off" or blinking or variation of hue, any change of state of the visual indicator 48 in the *Zenz* input device is not in response to a determination in a

computer. *Zenz* fails to cure the deficiency of *Adan* to teach or suggest the computer communicating with a computer input device as claimed.

In *Zenz*, the computer input device outputs to a computer but receives no signals from the computer. "The mouse shown in FIG. 3B also includes a wire 60, as an embodiment of output transmitter 32, connected to the computer (not shown) to relay signals from the computer input device to the computer." (Col. 5, lines 35-38). The internal components of mouse 30, shown in *Zenz*'s Fig. 2, show the output means 32 only outputting to a computer. Activation of the visual indicator 48 or change of state of the visual indicator 48 is controlled by or in response to sensors 42 and 43 and configuration circuit 46, all contained within mouse 30 and is not in response to a determination in a computer. (See *Zenz* Fig. 2). Indeed, the visual indicator 48 of *Zenz* is not "functionally equivalent to the desired illuminating member of [Applicants'] input device," as alleged by the Action. As such, *Adan* and *Zenz*, either alone or in combination, fail to teach or suggest at least Applicants' claims 1 and 28 feature of, "communicating with a computer input device having an illumination member to cause the illumination member to change states responsive to the determining step." *Eichstaedt* also fails to cure this deficiency of the combination of *Adan* and *Zenz*.

Further, the Action states that, "Adan does not teach the use of [an] input device in connection to [Applicants'] step of determining in a computer whether a predetermined event has occurred." To overcome this deficiency, the Action relies on the Abstract of *Eichstaedt* and contends that, "Eichstaedt teaches a tactile notification device that can be embodied." The Action continues to allege that, "Eichstaedt cites as an example [of] a palm top computer receiving an email, and sending a signal to the notification device, which generates [a] discrete tactile signal." The Action further alleges that, "Eichstaedt teaches that the notification device can generate different tactile signals, and each tactile signal can be correlated as desired by the user." The Action ends by alleging that, "it would have been obvious to one skilled in the art at the time the invention was made to modify Adan's computer system to adapt Eichstaedt's tactile notification device" and that, "[o]ne would have been motivated in view of the suggestion in Eichstaedt that the tactile notification device performs the desired determination of a predetermined event."

*Eichstaedt* describes an integrated touch-skin notification system for a wristwatch worn by a user. As shown in *Eichstaedt* Figures 1 and 2 and described in the corresponding specification, a laptop computer 20 can transmit a wireless signal via network 14 to the watch. Once the wireless signal is received by the watch, a pinch of a user's skin is conducted upon the user's wrist. The *Eichstaedt* user wearable tactile notification device 12 is not a mouse or other computer input device. In fact, the watch 12 is a one way receiver that pinches the user when a page has been received at the user's wearable pager 16 or a new telephone call has arrived at the user's wireless telephone 22. *Eichstaedt* allows a user to receive a notification of a new email or new telephone call by the watch, but fails to teach, suggest, or describe such a mouse or other computer input device. *Eichstaedt* fails to cure the deficiency of *Adan* to teach or suggest communicating with a computer input device as claimed. As such, *Adan* and *Eichstaedt*, either alone or in combination, fail to teach or suggest at least Applicants' claims 1 and 28 feature, "communicating with a computer input device having an illumination member to cause the illumination member to change states responsive to the determining step." *Zenz* also fails to cure this deficiency of the combination of *Adan* and *Eichstaedt*.

Further, Applicants submit that the Action has failed to identify any suggestion, incentive or motivation to combine *Adan*, *Zenz*, and *Eichstaedt* at the time of the invention as alleged. *Adan* and *Zenz* are directed to computer mice intended to provide signals to the computer without receiving any determination by the computer. *Eichstaedt* is directed to a watch receiver that pinches the user's skin and does not and can not provide input to the computer. In explaining that one skilled in the art would have modified *Adan*'s "input device system to adapt Zenz's visual indicator (48)," the Action merely asserts that, "the use of a visual indicator (48) helps function a computer input device more efficiently as taught by Zenz." In explaining that one skilled in the art would have modified *Adan* "to adapt Eichstaedt's tactile notification device," the Action merely asserts that, "[t]he use of [a] tactile notification device helps function personal computing devices as taught by Eichstaedt." However, the Action's reason for combining the references to attempt to obtain the claimed invention is insufficient to establish a *prima facie* rejection based on 35 U.S.C. § 103(a). Namely, the Action has taken three unrelated patents and has attempted to combine features not found in any patent alone or in combination

without a sustainable motivation to combine. The Action cites features from three references and combines these with Applicants' written description as a roadmap to allege an obviousness type rejection without establishing a proper motivation to combine. In light of the foregoing, the combination of *Adan*, *Zenz* and *Eichstaedt* is improper and therefore does not render the claimed invention obvious. Therefore, Applicants submit that claims 1 and 28 distinguish over the prior art of record and are in condition for allowance. Withdrawal of the rejection is respectfully requested.

Applicants' independent claim 6 recites, among other features, "changing a state associated with the illumination member in response to the determination step." Again, as stated above in reference to Applicants' claims 1 and 28, contrary to the Action's assertion, the combination of *Adan*, *Zenz* and *Eichstaedt* fails to teach or suggest at least this feature of Applicants' independent claim 6. As already stated above, *Adan* describes an input device that at best detects images on a surface. (Col. 2, line 61). *Adan* does not teach or suggest communication with an input device as claimed. Further, *Zenz* and *Eichstaedt* fail to cure the deficiency of *Adan* to teach or suggest communicating with a computer input device as claimed. *Adan*, *Zenz*, or *Eichstaedt*, either alone or in combination, fails to teach or suggest "changing a state associated with the illumination member in response to the determination step," as recited, among other features in Applicants' independent claim 6. Thus, the Action has failed to provide a proper *prima facie* case of obviousness and the rejection is therefore respectfully traversed. Withdrawal of the rejection is respectfully requested.

Claims 2-5, 7-27 and 33, and 29-32 and 34 are dependent on claims 1, 6, and 28, respectively, and are believed to be allowable over the prior art for at least the above stated reasons and further in view of the additional advantageous features recited therein.

For example, the applied art does not provide a teaching or suggestion of, "wherein said changing step includes transmitting a signal to the computer input device," as recited, among other features, in Applicants' dependent claim 7. The Action cites a "mouse message hook" description of *Adan* and column 7, lines 15-20. As admitted by the Action, "the called mouse message hook executes and returns a value to operating system 35 that instructs the operating system to pass the mouse message to the next registered mouse message hook." Operating

system 35 of *Adan* is in the computer 20. As such, the mouse message hook fails to transmit a signal to the mouse 42. *Adan* clearly does not teach or suggest, "wherein said changing step includes transmitting a signal to the computer input device," as recited, among other features in Applicant's claim 7.

In reference to Applicants' claim 9, the Action cites *Adan*'s Figure 10B and reference elements 192 and 196. Applicants' dependent claim 9 recites, among other features, "determining whether at least one e-mail message has been received." Contrary to the Action's assertion, Figure 10B and reference elements 192 and 196 of *Adan* describe communication with an operating system 35 in a computer 20 and not an input device. Further, step 192 of *Adan* is a determination in response to a mouse message received from the mouse driver (step 190). The determination step 192 is in response to an image captured in a mouse (step 176) and not a determination as to whether at least one e-mail message has been received. *Adan* clearly does not teach or suggest, "determining whether at least one e-mail message has been received," as recited, among other features in Applicant's claim 9.

Further, in regards to Applicants' claim 19, the Action cites Figure 3 of *Adan* as allegedly teaching the use of the input device with respect to game applications. Applicants' claim 19 recites, among other features, "determining whether a correct answer has been input." Figure 3 of *Adan* is described between col. 7, line 34 and col. 8, line 65. As stated in the specification, Figure 3 "is a more detailed diagram... illustrating an operator input device, such as mouse 42, in accordance with one embodiment of the present invention." (Col. 7, lines 34-37). The cited Figure 3 of *Adan* describes nothing more than the internal components of a mouse 42. Clearly, neither the cited Figure 3 of *Adan*, nor any other portion of *Adan*, *Zenz*, or *Eichstaedt*, either alone or in combination, teach or suggest a gaming environment or the step of, "determining whether a correct answer has been input," as recited, among other features, in Applicants' claim 19.

Applicants understand that the Declaration under 37 C.F.R. § 1.131 that accompanied the Response to Final Office Action filed on March 10, 2004, was sufficient to meet the requirements under 37 C.F.R. § 1.131, and has established a date of invention of the subject matter of at least claims 1-3, 6-10, 21, 27-28, and 30 prior to any reference having a priority or

publication date after February 19, 2000. Applicants respectfully request that the Examiner contact Applicants' undersigned representative if this understanding is not correct.

## CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. No fee is believed due, however, if any fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,
**BANNER & WITCOFF, LTD.**

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